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WASHINGTON, D.C. 20231  
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2002 1002

Paper No. 5

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COPY MAILED

OCT 11 2002

OFFICE OF PETITIONS

In re Application of :  
Ian A. Stewart :  
Application No. 10/085,524 : DECISION REFUSING STATUS  
Filed: 26 February, 2002 : UNDER 37 CFR 1.47(b)  
Attorney Docket No. WRLD-1-1013 :

This is in response to the petition filed on 3 June, 2002, under 37 CFR 1.47(b)<sup>1</sup>.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 26 February, 2002, without an executed oath or declaration.

Accordingly, on 25 March, 2002, Initial Patent Examination Division mailed a Notice To File Missing Parts of Nonprovisional Application requiring an executed oath or declaration and a

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<sup>1</sup>A petition under 37 CFR 1.47(a) is inappropriate in this instance since no inventor has signed the declaration. A petition under 37 CFR 1.47(a) is only appropriate where some of the named inventors signed the declaration and one or more of the named inventors refuses to sign or cannot be found.

surcharge for its late filing.

In response, on 3 June, 2002 (certificate of mailing date 24 May, 2002), the present petition was filed, accompanied by the late filing surcharge.

Petitioner asserts that the inventor has refused to sign the declaration.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks items (1), (2), (4), (5), and (6).

In regards to item (1), petitioners must supply proof that a copy of the application (specification including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review.<sup>2</sup> The showing of record is that only the declaration was ever sent to the inventor. Petitioners should submit a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign can be alleged, petitioners must show that the application papers were sent or given to the non-signing inventor. If the inventor refuses to sign the declaration in writing after being sent or given the application, a copy of that written refusal should be supplied with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

As to item (2), an oath or declaration for the patent application

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<sup>2</sup>MPEP 409.03(d).

in compliance with 37 CFR 1.63 and 1.64 has not been presented. The oath or declaration must identify the residence, mailing address, if the inventor lives at a different location from where he or she customarily receives mail, as well as the citizenship of the inventor. The oath or declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the non-signing inventor(s). The officer must identify his/her title in the declaration, as well as his/her mailing address, residence, if the applicant lives at a different location from where he or she customarily receives mail, as well as the citizenship of individual signing on behalf of the non-signing inventor. If the oath or declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.<sup>3</sup>

As to item (4), petitioner must provide the last known address of the non-signing inventor.<sup>4</sup>

In regards to item (5), petitioner must show proof of proprietary interest. Petitioner may make this showing by providing a copy of any employment agreement between the non-signing inventor and the Rule 1.47(b) applicant (employer); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant; or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

As to item (6), petitioner must provide a statement that the filing is necessary to prevent irreparable damage or to preserve the rights of the parties.<sup>5</sup>

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Assistant Commissioner for Patents  
                    Box DAC  
                    Washington, D.C. 20231

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<sup>3</sup>MPEP 409.03(b).


<sup>4</sup>MPEP 409.03(e).

<sup>5</sup>MPEP 409.03(g).

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.

  
Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy